



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,982	12/05/2001	Koichiro Nagare	Q67256	1346
23373	7590	01/26/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KEYS, ROSALYND ANN	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/001,982	Applicant(s) NAGARE, KOICHIRO	
	Examiner Rosalynd Keys	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17; 11/10; 8/25</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1621

DETAILED ACTION

Status of Claims

1. Claims 1-7 are pending.

Claims 1-7 are rejected.

Information Disclosure Statement

2. The information disclosure statements filed August 25, 2004 and September 17, 2004, and November 10, 2004 have been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirata et al. (EP 0 989 109), for the reasons given in the previous office action, mailed August 10, 2004. Further, the claimed POV is inherently taught, since the polyalkylene glycol monomer of Hirata et al. is the same as the instant polyalkylene glycol monomer. The limitations of claim 8 are inherent, since the compounds of the Hirata et al. are the same as those of the instant invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knebel et al. (6,040,473) in view of Hirata et al. (EP 0 989 109), for the reasons given in the previous office action, mailed August 10, 2004. Further, the claimed POV is inherently taught, since the polyalkylene glycol monomer of Knebel et al. is the same as the instant polyalkylene glycol monomer. The limitations of claim 8 are inherent, since the compounds of the Knebel et al. are the same as those of the instant invention.

7. Claims 1-3, 5 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aldrich Catalog 1998-1999 (pages 1365 and 1368).

Aldrich Catalog discloses poly(ethylene glycol) behenyl ether methacrylate in a 50 wt. % solution in methacrylic acid (25%)/water (25%) and poly(ethylene glycol) 2,4,6-tris(1-phenylethyl)phenyl ether methacrylate as a 60 wt.% solution in methacrylic acid(20 %)/water (20%). The limitations of claim 8 are inherent, since the compounds of the Aldrich catalog are the same as those of the instant invention.

Art Unit: 1621

The Aldrich Catalog fails to disclose that these monomers are stored and/or transferred. However, since these monomers have utility and are sold by Aldrich, one having ordinary skill in the art at the time the invention was made would have found it obvious to store and transport these monomers in a container for easy distribution

Response to Arguments

Rejection of claims 1-7 under 35 U.S.C. 102(b) as being anticipated by Hirata et al. (EP 0 989 109)

8. Applicant's arguments filed November 10, 2004 have been fully considered but they are not persuasive.

The Applicants argue that the reflux condenser of Hirata et al. is not a storage vessel within the meaning of a storage vessel of the instant invention. The Examiner disagrees. On page 5 of the specification storing or storage is disclosed as meaning comprising placing and storing a substance in a storage vessel for a while or continuously for a long period of time (see lines 3-6). The storage vessel and the transfer vessel respectively include not only containers and drums but also tanks on the ground, underground tanks and the like in the case of storage vessels (see lines 11-14). According to Webster's II New Riverside University Dictionary (1994) a container is defined as a receptacle for holding or carrying material (page 304). Thus, since the reflux condenser of Hirata et al. holds their 80% aqueous esterified product for several hours, it falls within the meaning of Applicants storage vessel.

For the above reasons this rejection is maintained.

Rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Hirata et al. (EP 0 989 109)

Art Unit: 1621

9. Applicant's arguments, see page 8, beginning at paragraph 3 to page 9, line 1, filed November 10, 2004, with respect to Claims 1-7 have been fully considered and are persuasive. The rejection of claims 1-7 has been withdrawn.

Rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Knebel et al. (6,040,473) in view of Hirata et al. (EP 0 989 109).

10. The Applicants believe that the instant invention would not have been obvious over Knebel et al. in view of Hirata et al. because Knebel et al. disclose nothing specifically with respect to the POV, nor does it focus on the importance of such aspect. This argument is not persuasive because POV of the polyalkylene glycol monomer of Knebel et al. would inherently be the same as the instant polyalkylene glycol monomer, since the compounds have the same structural formula, i.e. they are the same compounds.

For the above reasons this rejection is maintained.

Conclusion

11. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on September 17, 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension

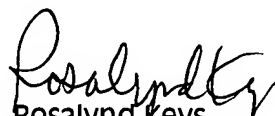
Art Unit: 1621

fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, R and F 3:00-8:00 pm and T-W 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
Art Unit 1621

January 21, 2005